

REMARKS

Reconsideration of this application and withdrawal of the rejections set forth in the Office Action made final mailed November 21, 2003, is requested in view of this preliminary amendment and the following remarks.

Rejection of Claims 1-50 under 35 U.S.C. Section 112

The examiner rejected claims 1-50 under 35 U.S.C. Section 112 as being indefinite. The examiner continues to assert that the term “powder” is “indefinite because it does not describe the component in terms of what it is,” but only the form of the substance. As Applicant explained in detail in his previous response, the term “powder” is not indefinite and indeed precisely describes an element of Applicant’s claimed invention. As previously noted, a powder is defined as a substance consisting of ground, pulverized, or otherwise finely dispersed solid particles. The American Heritage Dictionary, 2nd College Edition, 1985. This distinguishes the substance from other forms, such as a liquid, a gas, a paste, etc.

The examiner’s statement that powder may be a “face powder, gunpowder, talcum powder, a powdered drug,” only goes to show that the term “powder” may be broad, but it does not make the use of the term indefinite. Accordingly, the use of the term “powder” is not indefinite and to the contrary, describes precisely the form of substance claimed by Applicant.

As the examiner correctly points out, there are many different substances which may be a “powder,” including without limitation, plastisol having resin particles or thermoplastic copolyamides. However, the fact there are many different powders does not make the term “powder” indefinite.

Rejection of Claims 1-50 under 35 U.S.C. Section 103

In the Office Action, the examiner rejected claims 1-50, all of the then currently pending

claims, under 35 U.S.C. Section 103 as being unpatentable over Sammis (U.S. Patent No. 6,143,115) in view of Hurnik et al. (U.S. Patent No. 4,623,686). Applicant respectfully traverses this rejection and submits that it should be withdrawn because the cited prior art does not teach or suggest utilizing an ink compound and powder composed such that the image can be imprinted on a soft surface with heat applied to the heat transfer paper at a temperature in the range of 250 to 295 degrees Fahrenheit for up to 10 seconds. This is very important because some materials onto which the image is to be applied can be damaged (such as by being melted) by the application of excessive heat. For example, PVC and many PVC derivatives will melt under heating conditions exceeding 400 degrees Fahrenheit.

The examiner cites to Sammis as disclosing adhesives for applying an image at the temperatures of Applicant's claimed invention. However, the examiner has misinterpreted the disclosure of Sammis as compared to Applicant's claimed invention. The section of Sammis cited by the examiner at column 4, lines 61-63, states, "Ideally, the heating process heats the adhesive-abrasive particles to a temperature range of 118° C. to 143° C. [244° F. to 289°F]." (conversions added to original). But the examiner failed to point out that in the two preceding sentences Sammis explicitly states that the heat is applied at a temperature of "at least 300° C. [572° F.], and it is desired to heat the transfer sheet 10 for approximately 5 seconds. Preferably the adhesive abrasive particles are formed from a material having a melting point of between 105° C.-115° C. [221° F.-239° F.]" (conversions added to original).

These statements in Sammis are completely consistent with Applicant's previous arguments that the melting temperatures of the materials disclosed in Sammis and the required heating temperatures disclosed in Sammis are much higher than Applicant's claimed invention. Applicant's invention requires that the heat be applied at a temperature between 250° F.-295° F°

which is much lower than the 572° F. heating temperature disclosed in Sammis. It appears that the examiner has confused the material temperature range (105° C.-115° C. [221° F.-239° F.]) disclosed in Sammis with the heating temperature range of Applicant's claimed invention. The material temperature and the heating temperature are not the same thing. Since the materials are heated in a transient process (for example, less than 15 seconds in Applicant's claimed invention), the material temperatures do not reach a steady state temperature as high as the heating temperature. Of course, if left in the heater long enough, the materials would approach the heating temperature. This is quite clear from the process described in Sammis in which the heating temperature is 300° C. [572° F.] but the required temperature of the adhesive materials to properly melt them is between 118° C.-143° C. [244° F.-289° F]. (see Sammis, column 4, lines 58-66).

Accordingly, Sammis does not teach or suggest utilizing a powder which will allow imprinting of the image onto a soft surface under the heating conditions of the present invention. For example, the nylon and polyester materials disclosed in Sammis (col. 4, lines 29-30) must be heated at temperatures greater than 400 degrees Fahrenheit in order for these materials to provide the adhesive benefits described by Sammis.

Independent claims 1, 19, 36 and 42 have been amended to include the heating temperature limitation discussed above and are therefore patentable over the cited prior art. Since claims 2-18, 20-35, 37-41 and 43-50 depend from one of claims 1, 19, 36, or 42, these dependent claims are patentable over the cited prior art for at least the same reasons as the independent claims. In addition, new claims 51-52 are patentable over Sammis in view of Hurnik et al. for at least the same reasons. Accordingly, Applicant submits that claims 1-52 are now in allowable form.

Rejection of Claims 1-50 under 35 U.S.C. § 112

The examiner rejected claims 1-50 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The examiner found that there is no support in the originally filed specification for the limitation, "wherein said ink compound and powder are such that said image can be imprinted on said soft surface with heat applied to said heat transfer paper at a temperature in the range of 220 to 240 degrees Fahrenheit for up to 15 seconds."

Applicant has amended each of the independent claims 1, 19, 36 and 42 to include the correct temperature and time for the step of heating the heat transfer paper. This temperature range of 250° F. to 295° F. is supported in the originally filed specification, for example, at page 11, lines 8-10.

Accordingly, this rejection should be withdrawn in view of the current amendment.

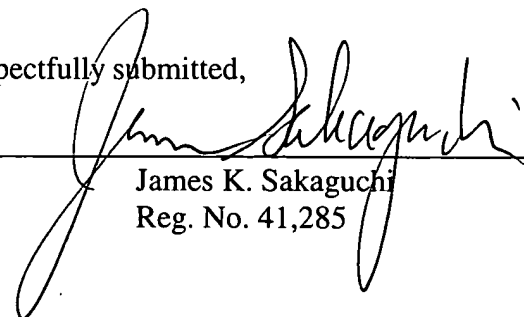
Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that all of the examiner's rejections have been overcome. Accordingly, allowance is earnestly solicited. If the examiner feels that a telephone interview could expedite resolution of any remaining issues, the examiner is encouraged to contact Applicant's undersigned representative at the phone number listed below.

Respectfully submitted,

Dated: March 22, 2004

By: _____


James K. Sakaguchi
Reg. No. 41,285

JKS:jks
Cohen & Sakaguchi LLP
2424 S.E. Bristol St. Suite 300
Newport Beach, CA 92660
Telephone: 760-803-5967
Facsimile: 949-625-8955